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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,038	03/24/2000	Scott J. Wolf	7883.0004-02	2278

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EXAMINER

BIANCO, PATRICIA

ART UNIT	PAPER NUMBER
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3762

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/534,038

Applicant(s)

WOLF ET AL.

Examiner

Patricia M Bianco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/24/00; 6/19/00; 8/31/00.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-7, drawn to a shunt having apertures and a diversion tube, classified in class 604, subclass 8.
 - II. Claim 8, drawn to a conduit device having vessel disc members attached, classified in class 623, subclass 1.36.
 - III. Claim 9, drawn to a stent having a movable flap on the end for blood control, classified in class 604, subclass 9.
 - IV. Claim 10, drawn to a conduit with an access port and graft segment, classified in class 623, subclass 1.13.
 - V. Claim 11, drawn to a shunt having a seal portion, classified in class 604, subclass 532.
 - VI. Claim 12, drawn to a stent having varying wall thickness, a bend and variable diameter, classified in class 623, subclass 1.3.
 - VII. Claim 13, drawn to a stent having a curved conduit with a spiral flow path, classified in class 623, subclass 1.15.
 - VIII. Claim 14, drawn to a stent having a vortex chamber and a tangential flow port, classified in class 623, subclass 1.22.
 - IX. Claim 15, drawn to a method for inserting a stent using an instrument, classified in class 623, subclass 1.11.

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The inventions are distinct, each from the other because of the following reasons:

2. Inventions **I and II**, **I and III**, **I and IV**, **I and V**, **I and VI**, **I and VII**, and **I and VIII** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. With respect to the different mode of operation of inventions **I and II**, invention II requires disc members for engagement with the vessel, which I does not. With respect to the different mode of operation of inventions **I and III**, invention III requires a movable flap on the end for blood control, which I does not. With respect to the different mode of operation of inventions **I and IV**, invention IV requires an access port and graft segment, which I does not. With respect to the different mode of operation of inventions **I and V**, invention V requires a seal portion on the shunt, which I does not. With respect to the different mode of operation of inventions **I and VI**, invention VI requires a varying wall thickness, a bend and variable diameter, which I does not. With respect to the different mode of operation of inventions **I and VII**, invention VII requires a curved conduit with a spiral flow path, which I does not. With respect to the different mode of operation of inventions **I and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which I does not.

3. Inventions **II and III**, **II and IV**, **II and V**, **II and VI**, **II and VII**, and **II and VIII** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as

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capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. With respect to the different mode of operation of inventions **II and III**, invention III requires a movable flap on the end for blood control, which II does not. With respect to the different mode of operation of inventions **II and IV**, invention IV requires an access port and graft segment, which II does not. With respect to the different mode of operation of inventions **II and V**, invention V requires a seal portion on the shunt, which II does not. With respect to the different mode of operation of inventions **II and VI**, invention VI requires a varying wall thickness, a bend and variable diameter, which II does not. With respect to the different mode of operation of inventions **II and VII**, invention VII requires a curved conduit with a spiral flow path, which II does not. With respect to the different mode of operation of inventions **II and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which II does not.

4. Inventions **III and IV**, **III and V**, **III and VI**, **III and VII**, and **III and VIII** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. With respect to the different mode of operation of inventions **III and IV**, invention IV requires an access port and graft segment, which III does not. With respect to the different mode of operation of

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inventions **III and V**, invention V requires a seal portion on the shunt, which III does not.

With respect to the different mode of operation of inventions **III and VI**, invention VI requires a varying wall thickness, a bend and variable diameter, which III does not.

With respect to the different mode of operation of inventions **III and VII**, invention VII requires a curved conduit with a spiral flow path, which III does not. With respect to the different mode of operation of inventions **III and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which III does not.

5. Inventions **IV and V**, **IV and VI**, **IV and VII**, and **IV and VIII** are unrelated.

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions

have different modes of operation. With respect to the different mode of operation of inventions **IV and V**, invention V requires a seal portion on the shunt, which IV does not.

With respect to the different mode of operation of inventions **IV and VI**, invention VI requires a varying wall thickness, a bend and variable diameter, which IV does not.

With respect to the different mode of operation of inventions **IV and VII**, invention VII requires a curved conduit with a spiral flow path, which IV does not. With respect to the different mode of operation of inventions **IV and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which IV does not.

6. Inventions **V and VI**, **V and VII**, and **V and VIII** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. With respect to the different mode of operation of inventions **V and VI**, invention VI requires a varying wall thickness, a bend and variable diameter, which V does not. With respect to the different mode of operation of inventions **V and VII**, invention VII requires a curved conduit with a spiral flow path, which V does not. With respect to the different mode of operation of inventions **V and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which V does not.

7. Inventions **VI and VII** and **VI and VIII** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. With respect to the different mode of operation of inventions **VI and VII**, invention VII requires a curved conduit with a spiral flow path, which VI does not. With respect to the different mode of operation of inventions **VI and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which VI does not.

8. Inventions **VII and VIII** are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of

operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation. With respect to the different mode of operation of inventions **VII and VIII**, invention VIII requires a vortex chamber and a tangential flow port, which VII does not.

9. Inventions I, II, III, IV, V, VI, VII, & VIII and IX are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the method as claimed can be practiced by hand since the stent can be inserted within the passageway through an incision by the hand of a surgeon

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

A telephone call was made to Susanne Tinker on February 2nd, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

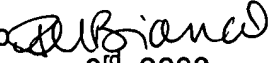
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning the rejections contained within this communication or earlier communications should be directed to examiner Tricia Bianco whose telephone number is (703) 305-1482. The examiner can normally be reached on Monday through Fridays, alternating Fridays off, from 9:00 AM until 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on (703) 308-5181. The official fax numbers for the organization where this application or proceeding is assigned is (703) 872-9302 for regular communications and for After Final communications (703) 872-9303.

Tricia Bianco
Patent Examiner
Art Unit 3762

pmb 
February 3rd, 2003